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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/551,252	04/18/2000	Adolf Brodbeck	(K) 53 928	1754

7590

04/07/2004

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EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 04/07/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/551,252

Applicant(s)

BRODBECK ET AL.

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-38 is/are pending in the application.
- 4a) Of the above claim(s) 20-34 and 36-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-19 and 35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \*    c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                      6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The response filed June 30, 2001 has been entered, and the responses filed December 26, 2001 and April 3, 2002 have been received. It is noted that, upon further consideration, the Miscellaneous Office action mailed January 29, 2003 has been vacated. Upon review, the response filed April 3, 2002 (paper no. 10) is considered to be fully responsive to the specific objections raised in the Office action mailed March 27, 2001 (paper no. 5). Therefore, no extension fee is required.

### ***Election/Restrictions***

2. Applicant's election without traverse of Group I (claims 17-19 and 35) in the response filed December 20, 2001 (paper no. 8) is acknowledged. Claims 20-34 and 36-38 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention. Regarding applicant's statement regarding claim 36, it is noted that claim 36 cannot be examined with claim 35 because it does not depend therefrom.

### ***Abstract***

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The

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abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because of the use of "said" in line 3.

Appropriate correction is required. See MPEP § 608.01(b).

### ***Drawings***

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "quick fixing devices" set forth in claim 19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

If a drawing change is necessary, a proposed drawing correction is required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

6. The substitute specification filed April 3, 2002 (paper no. 10) has been received but has not been entered because a statement that it contains no new matter did not accompany it. Applicant should review that version of the substitute specification and, if applicable, should provide such a statement in the next response. If no changes are necessary, it is not necessary to re-submit the substitute specification.

***Claim Rejections - 35 USC § 112, 1<sup>st</sup> paragraph***

7. Claims 17-19 and 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Upon further consideration, the operation of the ejector is not clear, particularly as to how it cooperates with the cutter and how it ejects a work piece.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

8. Claims 17-19 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 17, line 2, the recitation "arranged to receive" is vague and indefinite as to how the counter holder is "arranged" to perform the recited function; in lines 3-4, the recitation "on said counter holder" is vague and indefinite and appears to be inaccurate since the cutting tools are not disclosed as being "on" the counter holder; in line 7, "on which" is vague and indefinite as to what it refers (e.g., the slide or the counter-holder); in line 9, structural cooperation is lacking for "a programmable control", particularly with respect to the cutting tool and slide.

In claim 18, line 2, the comma “,” renders the limitation unclear and thus vague as to what is being set forth; also in line 2, “on which” is vague and indefinite as to what it refers.

In claim 19, line 1, the recitation “quick fixing devices” is vague and indefinite as to what disclosed structure it refers.

In claim 35, lines 1-2, structural cooperation is lacking for “an actuating drive”, particularly with respect to the guide and slide; in lines 2-3, the recitation “in said guide” is vague and indefinite and appears to be inaccurate.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 17-19 and 35, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Luce, Sr., pn 3,481,234, in view of Sappenfield, pn 2,321,323, or Engel et al., pn 5,019,028.

Luce discloses a tube cutting apparatus with almost every structural limitation of the claimed invention as best understood from the claims but lacks an ejector.

However, the Examiner takes Official notice that such ejectors are old and well known in the art and provide various known benefits including facilitating removing a work piece such as a tube or the scrap cut therefrom from the apparatus. Sappenfield and Engel

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disclose examples of such ejectors. Therefore, it would have been obvious to one having ordinary skill in the art to provide an ejector on the cutting apparatus of Luce for the well known benefits including that described above.

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (703)308-1404. The examiner can normally be reached on Wednesdays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on (703)308-1082. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cfd  
March 30, 2004